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Attorney Docket No. 09877.0189-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
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Giacomo Stefano Roba *et al.*) Group Art Unit: 1731
)
Application No.: 09/986,622) Examiner: John M. Hoffman
)
Filed: November 9, 2001)
)
For: METHOD AND INDUCTION) Confirmation No.: 5933
FURNACE FOR DRAWING)
LARGE DIAMETER PREFORMS)
TO OPTICAL FIBRES)

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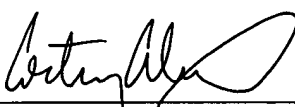
Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Further to the Notice of Appeal filed concurrently herewith, Applicants request review, before the filing of an Appeal Brief, of the Final Office Action dated August 16, 2007, in the above-identified application. No amendments are being filed with this request. Review is requested for the reasons stated in the five-page attachment to this paper, entitled "Arguments for Consideration." The undersigned is an attorney of record.

Respectfully submitted,
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GARRETT & DUNNER, L.L.P.

Dated: February 13, 2008

By: 
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ARGUMENTS FOR CONSIDERATION

Claims 34-37, 40-45, and 51 are pending in this application and stand rejected in the Final Office Action dated August 16, 2007 ("Final Office Action"). In an Amendment After Final dated December 13, 2007, Applicants proposed canceling claims 34-37 and 40-45, as well as to address an objection to the drawings raised by the Examiner in the Final Office Action. The Examiner declined to enter the Amendment After Final. In the accompanying Notice of Appeal, Applicants do not appeal the Examiner's rejection of claims 34-37 and 40-45.¹

This application describes methods and induction furnaces for drawing large diameter preforms to optical fibers. Claim 51 is directed to a drawing furnace for drawing an optical preform and recites, among other things,

a distributor body having a substantially annular distribution chamber, a distribution ring, and an outlet in fluid communication with an interior of the muffle, the distributor body configured to receive conditioning gas substantially tangentially with respect to the substantially annular distribution chamber, the distribution ring being adapted to uniformly introduce and forcedly direct a first portion of the conditioning gas into the muffle in a downward direction towards said furnace body and to direct a second portion of the conditioning gas to an upper portion of the substantially annular distribution chamber to create a buffer of conditioning gas having a pressure higher than a pressure outside the drawing furnace.

In the Final Office Action, the Examiner rejected claim 51 under 35 U.S.C. § 103 as being obvious over U.S. Patent Application No. 2002/0029591 (or U.S. Patent No.

¹ While the Applicants do not agree with the Examiner's rejection of claims 34-37 and 40-45, Applicants have canceled these claims in an effort to advance prosecution of claim 51. Applicants reserve the right to continue prosecution of the subject matter recited in claims 34-37 and 40-45 in a continuing application. Also, in the Amendment After Final, Applicants proposed introducing dependent claims 52-60 that corresponded to previously pending claims depending from claim 34. While these proposed dependent claims are not addressed in these Arguments for Consideration, Applicants reserve the right to introduce these dependent claims later in prosecution.

5,284,499 ("Harvey") in view of JP 08091862 ("Kazuya"), U.S. Patent No. 5,160,359 ("Strackenbrock"), U.S. Patent No. 4,547,644 ("Bair"), and optionally in view of U.S. Patent No. 4,988,374 ("Harding") and U.S. Patent No. 4,030,901 ("Kaiser"). The Examiner did not specifically explain why he asserts those references teach each recitation of claim 51, stating "[s]ee the prior Office action for the manner in which the combination of references would have all of the limitations of the claims." Final Office Action at 3.

However, the prior Office Actions did not explain why the Examiner believes the cited art teaches all recitations of claim 51. For example, while claim 51 was rejected in the May 21, 2007 Office Action, the Examiner did not explain in that Office Action how the references teach or suggest each limitation of claim 51, instead again stating "[s]ee the prior Office action for the manner in which the combination of references would have all of the limitations of the claims." But in the preceding November 20, 2006 Office Action, the Examiner had not rejected claim 51 under § 103. Instead, in the November 20th Office Action, claim 51 was rejected only under 35 U.S.C. § 112, ¶ 1.

In a December 19, 2007 Advisory Action declining to enter Applicants' December 13th Amendment After Final, the Examiner asserted that

all the features [of claim 51] have been addressed previously. For example see the rejection of 12-02-2004 which points out that a distributor body would have been obvious. The rejection does not state that claim 51 has been previously rejected. It is clear that claim 51 is merely claiming the same invention, but in a slightly different way. All of the features of the claim have been previously addressed.

Advisory Action at 3. However, while the Examiner did assert in the December 2, 2004 Office Action that a "distributor body" as recited in then-pending claim 34 was obvious,

claim 34 did not recite all the features of claim 51. In particular, then-pending claim 34 did not recite, as does claim 51, a distributor body including a distribution ring

being adapted to uniformly introduce and forcedly direct a first portion of the conditioning gas into the muffle in a downward direction towards said furnace body and to direct a second portion of the conditioning gas to an upper portion of the substantially annular distribution chamber to create a buffer of conditioning gas having a pressure higher than a pressure outside the drawing furnace.

Claim 51. Thus, contrary to the Examiner's suggestion in the December 19th Advisory Action, all features of claim 51 have not been addressed in previous Office Actions.

In the Final Office Action, the Examiner also suggested that the above-quoted recitation of claim 51 is "clearly met for the reasons of record." Final Office Action at 6. Applicants respectfully disagree because the Examiner has not explained how the art of record supports a rejection of claim 51, particularly with respect to the above-quoted recitation. Accordingly, a *prima facie* case of obviousness has not been established in accordance with the MPEP and applicable law:

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit.

MPEP 2142. The MPEP goes on to note that "The Federal Circuit has stated that 'rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.'" MPEP 2142 (*quoting In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Here, the above-quoted recitation of claim 51 has not been presented in any other claim. Accordingly, the previous rejections of other claims

do not clearly articulate the reason why the Examiner believes the cited art teaches or suggests this recitation.

In the Final Office Action, the Examiner also contended that "Applicant has not pointed out any patentable novelty in claim 51," citing MPEP 714.04 and 37 C.F.R. § 1.111. Final Office Action at 7. But as discussed in Applicants' July 31, 2007 Amendment, claim 51 recites subject matter that patentably distinguishes it from the cited art, such as:

a distributor body having a substantially annular distribution chamber, a distribution ring, and an outlet in fluid communication with an interior of the muffle, the distributor body configured to receive conditioning gas substantially tangentially with respect to the substantially annular distribution chamber, the distribution ring being adapted to uniformly introduce and forcedly direct a first portion of the conditioning gas into the muffle in a downward direction towards said furnace body and to direct a second portion of the conditioning gas to an upper portion of the substantially annular distribution chamber to create a buffer of conditioning gas having a pressure higher than a pressure outside the drawing furnace.

Applicants pointed out in the July 31st Amendment that this feature is not found in the prior art, and that a *prima facie* case of obviousness has not been established.

Amendment of July 31, 2007 at 14. Thus, Applicants respectfully disagree with the Examiner's contention that Applicants have not pointed out the patentable novelty of claim 51 in accordance with MPEP 714.04 and 37 C.F.R. § 1.111.

In the December 19th Advisory Action, the Examiner asserted that Applicants' explanation that the above-quoted feature of claim 51 is not found in the prior art does not distinguish the claim from the prior art, but is instead only a general allegation of patentability. Applicants respectfully disagree. MPEP § 2666 states that "[a] general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does

not comply with the requirements of this section.” Here, Applicants have directed the Examiner to language of claim 51 patentably distinguishing it from the cited references. Accordingly, Applicants have not simply made a general allegation of patentability.

Because the cited references do not disclose at least the recitation of claim 51 discussed herein, a *prima facie* case of obviousness has not been established, and Applicants respectfully assert that the rejection of claim 51 be withdrawn.